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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
05-629

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Application Number
10/544,297

Filed
8/3/05

on December 27, 2007

Signature /A. Blair Hughes/

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Typed or printed
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Art Unit
3671

Examiner
Keefe

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/A. Blair Hughes/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number If acting under 37 CFR 1.34 _____

December 27, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 05-629)

In the Application of:)	
)	
Christopher J. Lyddon et al)	Examiner: S.L. Keefe
)	
Serial No. 10/544,297)	
)	
Filed: August 3, 2005)	Group Art Unit: 3671
)	
Title: Vehicle Arresting Device)	Confirmation No. 8152
)	
Commissioner for Patents		
P.O. Box 1450		
Alexandria, VA 22313-1450		

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW REMARKS

Pre-appeal brief review is requested for the above application. This paper sets forth Applicant's concise statement of clear errors in the Examiner's final rejection.

I. BACKGROUND

Claims 1-17 and 22-28 are pending in the application. Claims 1-8, 10-12, 17, 23 and 26-28 stand rejected for obviousness over Ousterhout et al. (USP 6,312,188) in view of Horton (USP 6,409,420) or further in view of Marphetia (claims 2-5). Claims 13-16, 22, and 24-25 are allowed and claim 9 is objected to for depending upon a rejected base claim.

II. TRAVERSE OF THE OBVIOUSNESS REJECTION

A. The Examiner Has Not Established *Prima Facie* Obviousness

Independent claims 1 and 26 are patentable because the examiner has not shown that the prior art discloses a device including a net having, in use, "any widthwise portion of the net [that] is capable of substantial transverse elongation". This feature of the claimed invention is discussed for example at page 5, line 21 to page 6, line 8 of the application. This claim feature is not taught by Ousterhout et al. or Horton. The examiner appears to refer to Figures 20-23 of Ousterhout et al. for disclosing this feature of the claimed invention. However, Figures 20-23 refer to a capture line and not a net. Even in the case of net 20 in Figure 4 of Ousterhout et al. which has loops elongated in the vertical direction and not the claimed fore and aft direction of a

laid-flat net, there is no substantial transverse elongation as claimed because there is no disclosure or suggestion that the three illustrated horizontal webs of the net are also sufficiently stretchy. Claims 1-8, 10-12, 17, 23 and 26-28 are non-obvious and patentable since this feature is not disclosed in the cited prior art.

B. Ousterhout et al. Does Not Disclose A “Net Adapted To Be Laid On The Ground In The Path Of A Vehicle To Be Arrested”

The examiner has not shown that Ousterhout et al. discloses a “net adapted to be laid on the ground in the path of a vehicle to be arrested”. It is the examiner’s position that the reference need not show this claim feature because: (1) the “adapted to” clause is not a patentable limitation (citing *In re Hutchinson*, 69 USPQ 138 (CCPA 1946)); and (2) Ousterhout et al. discloses in Figure 1 a net 20 that is laid flat on the ground in a stored position and then is raised above the ground to arrest the vehicle. Neither position is supportable.

1. The “adapted to” clause should be given patentable weight

The examiner’s reliance on *In re Hutchinson* to for the proposition that the “adapted” is of no patentable significance is faulty. Firstly, the “adapted to” clause in *In re Hutchinson* was in the claim preamble which is usually given no patentable weight. In the present claims, the “adapted to” clause is not in the preamble. Instead, it is used to define the “net” element. More importantly, MPEP §2111.04 states that the determination of whether clauses such as “adapted to” are claim limitations “depends upon the specific facts of the case”. MPEP §2111.04 (8th Ed. Rev. 6 2007). The MPEP section refers to *Hoffer v. Microsoft Corp.*, 74 USPQ2nd 1481 (Fed. Cir. 2005) for the proposition that a whereby clause cannot be ignored where it states a condition that is material to patentability. *Id.* at 1483. In the current claims, the “adapted to” language further defines the net element by the purpose of its design so it must be considered. Therefore, claims 1-8, 10-12, 17, 23 and 26-28 are non-obvious and patentable at least because Ousterhout et al. does not disclose or suggest this claim feature.

2. Ousterhout et al. does not disclose a “net adapted to be laid on the ground”

The examiner’s position that Ousterhout et al. somehow discloses the “net adapted to be laid on the ground” is also without merit. Ousterhout et al. Figure 1 discloses a vehicle immobilizer where the net is oriented in a vertical position to arrest the motion of a vehicle. Nonetheless, the examiner asserts that Figure 1 discloses a net “adapted to be laid on the ground” because the net can be laid flat on the ground in a stored position. (See Advisory Action at page

2). The examiner's position is clearly based upon hindsight, is contrary to how one skilled in the art would understand the invention and it finds no support in the Ousterhout et al. specification. The Ousterhout et al. specification has no teaching whatsoever about how the device is stored. Therefore, the examiner's position that the Ousterhout et al. net can be laid on the ground when stored is not based upon an express reference teaching – instead it is based upon an improper hindsight review of the reference with the applicant's invention in mind. Additionally, there is no teaching in Ousterhout et al. – as there must be – that would suggest to a skilled person that he *should* lay Ousterhout et al's net flat on the ground, since the only way in which the Ousterhout et al. net it is taught to work is by capturing a vehicle from an upright (vertical) position between supports 14, 16, as shown, for example, by the sequence of Figures 7 to 11.

The examiner is also wrong in suggesting that Ousterhout et al's net 20 can be laid flat on the ground in a *stored* position. It is quite evident to one skilled in the art from Ousterhout et al. Figures 1 and 2 and the corresponding description (Col. 5, lns 3-28) that in the stored position the net 20 is held in an enclosure 26 that is narrower than the height of the net, so the net must be stored in a folded, not flat, condition. For each of these reasons, claims 1-8, 10-12, 17, 23 and 26-28 are non-obvious and patentable.

C. The Prior Art Does Not Teach Upwardly-Directed Spikes Attached To Ousterhout et al's Net At A Leading Portion Thereof

It is the examiner's position that Ousterhout et al. does not disclose an arresting device including the use of tire puncturing spikes attached to a net. The examiner relies upon Horton for providing this missing teaching. The examiner's rejection is without merit because (1) the combination of Ousterhout et al. and Horton would not result in the claimed invention; and (2) one skilled in the art at the time of the invention would not have combined Ousterhout et al. and Horton as the examiner has.

1. Combining Ousterhout et al. and Horton would not result in the claimed invention

All claims are directed to a net that includes "upwardly- directed spikes". Claims 1-8, 10-12, 17, 23 and 26-28 are non-obvious because the combination of Ousterhout et al. and Horton would not result in a structure that includes upwardly-directed spikes. Indeed, if the Horton spikes were attached to the Ousterhout et al. net, the result would be a net 20 hanging in a

vertical orientation with attached spikes directed horizontally where it would be doubtful that they would engage tires.

2. A skilled artesian would not combine Ousterhout et al. and Horton

The examiner's obviousness rejection also cannot stand because one skilled in the art would not have combined Ousterhout et al. and Horton at all because the devices disclosed in each of the references work in entirely different ways. Spikes are essential to Horton's method of operation in that they interconnect the front and rear wheels or engage a pipe or the like rigid member under the vehicle frame. Ousterhout et al., on the other hand, uses an upright net to immobilize a vehicle. Clearly one skilled in the art would consider the Horton apparatus that uses a horizontal net and spikes to be irrelevant to a device such as Ousterhout et al.'s that uses a vertical net and the combination would not be made.

Moreover, the Ousterhout et al. device already has tire piercing spikes 32 on the barrier enclosure 26. (Col. 5, lns 20-33). These Ousterhout et al. spikes are intended to puncture tires (but cannot act to attach the net to those tires). Thus, one skilled in the art at the time of the invention would also not have combined Ousterhout et al. with Horton because there would be no need to add the tire piercing spikes of Horton to the Ousterhout et al. device that already included spikes for its own purposes. Claims 1-8, 10-12, 17, 23 and 26-28 are, therefore, non-obvious and patentable for these reasons as well.

D. Claims 17 Is Independently Patentable

Claim 17 is independently patentable over the cited prior art. The examiner rejected claim 17 for obviousness because modifying the Ousterhout et al. device with the Horton spikes would "obviously cause the net to wrap around the wheels of a vehicle." Claim 17 includes a feature whereby "the portion [of the device] thereof between the wheels of the vehicle is pulled tight under the vehicle, thereby preventing further rotation of those wheels". However, this is not how the devices of either Ousterhout et al or Horton effect an arrest or would effect an arrest if combined. Firstly, as shown above, it would not be obvious to add tire piercing spikes to the net of Ousterhout et al. Secondly, even if they were added, there is no teaching in either reference to place the spikes in the net to cause the net portion between the wheels to be pulled tight under the vehicle. Thirdly, since Ousterhout et al. depend on their net being in an upright position so that the vehicle is captured by the net, it would not be desired in Ousterhout et al. to have the net

dragged underneath the vehicle as would happen if "tire piercing spikes... cause the net to wrap around the wheels of the vehicle" as required by claim 17. For these reasons, claim 17 is non-obvious and patentable.

E. Claims 26-28 Are Independently Patentable

Independent claim 26 requires the "material of the net encircle[s] respective shaft portions". This feature of claim 26 et al. is not disclosed or suggested in the prior art. The examiner's apparent position that this limitation of claim 26 "is quite obvious to the teachings of Horton" and that "the teaching of Horton provides for that material of the net to encircle respective shaft positions of the spike assembly" is completely unfounded. Figure 3 of Horton shows how their spike assemblies are attached to their net. The material of the net is cable 26 and the shaft portion of the spike is shank 51. There is no way that the former can be said to encircle the latter. As a result, the prior art does not disclose this feature and independent claim 26 and all claims dependent thereon are non-obvious and patentable.

Respectfully submitted,

Date: December 27, 2007

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